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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,152	09/24/2003	Federico J. Benetti	GUID-008CON2	2852
36154	7590	03/30/2006	EXAMINER	
LAW OFFICE OF ALAN W. CANNON 834 SOUTH WOLFE ROAD SUNNYVALE, CA 94086			PHILOGENE, PEDRO	
			ART UNIT	PAPER NUMBER

3733

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/670,152	BENETTI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Pedro Philogene	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-17, 19-21 and 24-36 is/are rejected.
- 7) ☒ Claim(s) 18, 22 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/24/03</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13,24-28,31-34,36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,8-20 of U.S. Patent No. 6,199,556 in view of Nicholas et al. (5,967,974).

With respect to the above claims, it is noted that the patent claims disclose all the limitation, except for the main body or retractor remains resting against the frontal body of the patient; as claimed by applicant in claims 13,24-28,31-34,36,31. However, in a similar art, Nicholas et al evidences the use of a surgical retractor having a main body or retractor that remain resting (at least partially) against the frontal body of the patient so as to help elevate one side of the retractor body thereby lifting at least a portion of the ribs of the patient.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device '556 as taught by Nicholas et al.,

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to help elevate one side of the retractor body thereby lifting at least a portion of the ribs of the patient.

Claims 13,24-28,31-34,36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,736,774 in view of Nicholas et al. (5,967,974).

With respect to the above claims, it is noted that the patent claims disclose all the limitation, except for the main body or retractor remains resting against the frontal body of the patient; as claimed by applicant in claims 13,24-28,31-34,36,31. However, in a similar art, Nicholas et al evidences the use of a surgical retractor having a main body or retractor that remains resting (at least partially) against the frontal body of the patient so as to help elevate one side of the retractor body thereby lifting at least a portion of the ribs of the patient.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device '556 as taught by Nicholas et al., to help elevate one side of the retractor body thereby lifting at least a portion of the ribs of the patient.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13-17, 19-21,31,36 are rejected under 35 U.S.C. 102(e) as being anticipated by Nicholas et al. (5,967,974).

With respect to claims 12, 31, Nicholas et al disclose a surgical apparatus for accessing a beating heart, the apparatus comprising a main body (110) configured to rest against the frontal body of a patient; and a lifting arm (126) movably mounted to the main body and adapted to engage and lift at least a portion of the ribs of the patient, relative to remainder of the patient's body below the rib cage, while the body or retractor remains resting against the front body of the patient, when the patient is positioned horizontally; as set forth in column 4, lines 58-67, column 5, lines 1-7.

With respect to claims 14-17, 19-21,36, Nicholas et al disclose all the limitations, as set forth in column 3, lines 8-56, column 4, lines 15-67, column 5, lines 1-67, column 6, lines 1-24; and as best seen in FIGS.1-18. For example, contact points, such as the side of the frame that stays connected to the body, retractor arm (112) that moves in a direction different from a direction of the lifting; driving mechanism (120, 128) for driving the retractor and lifting arm.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 29,30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholas et al. (5,967,974) in view of Asrican (3,680,546).

With respect to the above claims, it is noted that Nicholas did not teach of fiber optic light; as claimed by applicant. However, in a similar art, Asrican evidences the use of fiber optic light to serve to direct the direction of light in the chest cavity.

Therefore, given the teaching of Asrican, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Nicholas et al., as taught by Asrican, to serve to direct the direction of light in the chest cavity.

#### ***Response to Amendment***

Applicant's arguments filed 1/17/06 have been fully considered but they are not persuasive. Applicant stated that Nicholas et al. is not configured to rest against the frontal body of the patient. The examiner begs to differ. In column 5, lines 1-7, Nicholas discloses that only one side of the retractor is elevated, therefore the other side of the retractor is still resting against the frontal body of the patient. Since part of the retractor body is still remained in resting position against the body, the reference meets the limitation.

With regard to the double patenting rejection the '556 and the '774 disclose all the limitations, except for the main body or retractor maintains the resting position against the frontal body of the patient; as now claimed by applicant. However, Nicholas et al in column 5, lines 1-7, discloses that only one side of the retractor is elevated, therefore the other side of the retractor is still resting against the frontal body of the

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patient. Since part of the retractor body is still remained in resting position against the body, the combination of Nicholas with the '556 and '774 patents meets the claims.

***Allowable Subject Matter***

Claims 18, 22, 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-


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4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene  
March 27, 2006

  
PEDRO PHILOGENE  
EXAMINER